REMARKS

This Reply is filed in response to the February 5, 2010 Office Action.[1] Claims 1-20 were presented for examination and were rejected. Claims 1, 7, 13, 18 and 20 are in independent form. No claims are amended. Claims 1-20 are pending.

Claims 1-5 and 7-11 are rejected under 35 U.S.C. §103(a), as being un-patentable over Lue Chee Lip et al. (U.S. 2002/0099794 A1; hereinafter "Lip") in view of Nguyen et al. (U.S. 7,523,385; hereinafter "Nguyen") and Official Notice of which one aspect is newly-cited. Claims 6 and 12 are rejected under 35 U.S.C. §103(a), as being un-patentable over Lip in view of Nguyen as applied to claims 1-5 and 7-11, further in view of Williams (U.S. 2004/0243435; hereinafter "Williams"). Claims 13-17 are also rejected under 35 U.S.C. §103(a) as being un-patentable over Lip in view of Nguyen, Williams and Official Notice of which one aspect is newly-cited. Lastly, claims 18 -20 are rejected under 35 U.S.C. §103(a) as being un-patentable over Nguyen in view of Lip, Williams and Official Notice of which one aspect is newly cited. These rejections are traversed because these references, taken individually or in any reasonable combination, do not disclose or suggest the subject matter recited in Applicants' claims for at least the following reasons.

NEWLY-CITED OFFICIAL NOTICE:

Applicants respectfully disagree with the position taken by the Examiner in the "Response to Arguments" section of the Office Action (pg 2) which says:

---

[1] The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicants may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicants do not automatically subscribe to, or acquiesce in, any such statement.

> "that there is an important implied fact in the newly amended claims: that the 'one of the plurality of potential visitors' *has* the information necessary to send a registration request for each of the plurality of potential visitors named in the visitation request.
>
> This implied fact is not mentioned in Applicant's specification, leading Examiner to conclude that the steps necessary for 'one of the plurality of visitors' to have the required registration information for the plurality of potential visitors is old and well known." (Office Action, pg 2, emphasis in original)

Without necessarily acquiescing that such fact is implied, instead of expressed, Applicants respectfully disagree with the above statement that the: "implied fact is not mentioned in Applicant's specification." Rather, the fact associated with the so-called implied fact *is* mentioned in the specification, as demonstrated below.

But first, Applicants point out that the fact associated with the alleged important implied fact (collectively hereinafter referred to as the "Fact") was actually contained in Applicants' claims prior to the last amendment. The last amendment to the claims providing "the newly amended claims," to which the above Office Action passage refers, added certain claim language. For example, in claim 1, the language: "*each of said visitors being named in said request by said inmate*" was added. (Applicants' August 27, 2009 amendment; italics added) But, this added language was not required to bring the Fact into the claims. The Fact had been contained in the claims prior to the last amendment as shown, for example, by the following language in claim 1: "*means for receiving a visitation request from an inmate for a plurality of potential visitors to attend the same visitation*" and "*means for sending from one of the plurality of potential visitors a registration request for each of the plurality of potential visitors based upon the received visitation request.*" (claim 1, italics and emphasis added) One visitor has the necessary information based upon the received visitation request to send a registration request for each of the potential visitors, and this notion is contained in the version of claim 1 which pre-existed the last added claim language. The Fact is thus contained in the version of claim 1 which

pre-existed the last added claim language. To the extent that the merit of the Examiner's position hinges upon an immediate response to a first appearance of the Fact, Applicants hereby point out a delay in the Examiner's asserting that position.

More importantly, the Fact or the "implied fact" in the claims is actually expressed in Applicants' specification. From a reading of the specification one understands that it is the inmate who is the source of visitor information, including names and phone numbers of companion visitors invited to attend the same visit. This information is supplied to the "one of the plurality of potential visitors" to enable that "one" to send the registration request for each of the other potential visitors as well as himself/herself. For example, consider the following language from Applicants' specification:

> "Specifically, an inmate, via a prison interface 200 requests visitation privileges. While the inmate could enter this information directly via the prison interface, which can be, for example, either voice or graphical user interface driven, it should be appreciated than an inmate can cooperate with, for example, a department of corrections official to assist in navigating and entering visitation request information. In particular, the prison interface 200, in cooperation with the processor memory, I/O interface and database 150, communicates with the visitor registration module 110 which receives the basic data for the potential visitor. The basic data for the **one or more potential visitors** can generally include the phone number of the visitor, the inmate's identification, the relationship of the potential visitor to the inmate, the potential visitors first name, the potential visitors middle name, the potential visitors last name, the potential visitor name suffix, if any, or any other information as appropriate."(specification; paragraph [0020]; emphasis added)

Thus, an inmate may request visitation privileges and may enter the information directly via a GUI. The information, or basic data, **FOR ONE OR MORE POTENTIAL VISITORS**, as the specification clearly states, such as phone numbers, etc. is supplied by the inmate. This description expressly discloses multiple visitors named and requested by the inmate who is expressly described as supplying the basic contact information for all of the desired multiple visitors.

Reinforcing paragraph [0020], paragraph [0058], in discussing step 905 of Fig. 9 says: "In step S905, the inmate directly or indirectly supplies visitor(s) data" and the plural term "visitor(s)" means all of the invited visitors.

Moreover, the "basic data" of paragraph [0020] for the "one or more potential visitors" of paragraph [0020] is forwarded to, or received by, the "one of the plurality of potential visitors" recited in claim 1, as demonstrated by the following specification language:

> "Upon receiving the visitation request, a visitor registration module 110 contacts the potential visitor and informs the potential visitor of the visitation request and provides instructions on how to register. For example, the visitor registration module 110 can place an automated call to the potential visitor, can generate an e-mail which can be sent to the potential visitor, can automatically print a letter addressed to the potential visitor, or any other known or later developed methodology used for communicating to the potential visitor that **THEY** have been identified by a inmate as a potential visitor and requested to register for a visit." (specification; paragraph [0021]; emphasis added)

Clearly, this paragraph teaches that "the potential visitor" who is equivalent to the "one of the plurality of potential visitors" recited in claim 1 is contacted by the visitor registration module for purposes of "communicating to the potential visitor that **THEY** have been identified……to register for a visit." The "they" to which the passage refers is, clearly, the claim-recited "one or more potential visitors" established by the inmate in the first place when the inmate entered the plurality of visitors information into the prison interface 200, as described at least in paragraph [0020] of Applicants' specification, noted above.

This is an express teaching of a specific means and/or methodology germane to the circumstances described in Applicants' specification for providing information to one party to allow him/her to register other parties. Clearly, this is "mentioned" in the specification but the Examiner states: "This implied fact is not mentioned in Applicant's specification, leading Examiner to conclude that the steps necessary for 'one of the plurality of visitors' to have the required registration information for the plurality of potential visitors is old and well-known."

(Office Action, pg 2; emphasis added) Therefore, the Examiner must now arrive at the opposite conclusion because this Fact or this "important implied fact" is actually mentioned in Applicants' specification, as demonstrated above.

In further support of Applicants' position, consider paragraph [0056] in Applicants' specification:

> In order to schedule a visit to an inmate, and for an approved registration, the visitor must be registered as a visitor on the inmate's visitor list. A registered visitor will have a registration number assigned to them. **A visitor can schedule one or more visits at a time and the schedule may include more than one visitor**, each visitor having a valid registration number for that particular visit. Then, for example, when scheduling the visit, **the visitor will enter the registration number for each visitor that will accompany them during the visit**. Upon successful entry and validation of this information, the visitor will be issued a visitation confirmation number. (specification paragraph [0056]; emphasis added)

This paragraph is an express statement that "A visitor" who is the "one of the plurality of potential visitors" recited in claim 1 can schedule visits that "may include more than one visitor" and that "the visitor will enter the registration number for each visitor that will accompany them during the visit." The visitor gets information from the inmate via prison interface 200 and visitor registration module 110 which is expressly stated at least in paragraphs [0020] and [0021] discussed above.

Thus, specification paragraph [0056] is an additional example of an express teaching in Applicants' specification of a specific means and/or methodology for providing information to one party to allow him/her to register other parties which, therefore, further refutes the Examiner's statement: "This implied fact is not mentioned in Applicant's specification, leading Examiner to conclude that the steps necessary for 'one of the plurality of visitors' to have the required registration information for the plurality of potential visitors is old and well-known." (Office Action, pg 2; emphasis added) Because the implied fact is mentioned, and expressly so,

as noted above, the opposite conclusion must be reached wherefore it is NOT implied from a reading of Applicants' specification that it is old and well-known for one visitor to have the required registration information for other visitors.

Accordingly, for reasons given above, the newly-cited Official Notice taken for the first time in the instant Office Action which states: "Official Notice is given that it is old and well-known for one party to register another party (*as implied by Applicant's specification*)" (Office Action pgs: 5, 12, 16 and 20; emphasis added; hereinafter "Newly-Cited Official Notice") is traversed.

Independent claim 1, rejected under 35 U.S.C. §103(a), as being un-patentable over Lip in view of Nguyen and Official Notice of which one aspect is newly-cited is allowable at least because the Newly-Cited Official Notice fails for reasons given above. It is respectfully requested that the 35 U.S.C. §103(a) rejection of claim 1 be withdrawn and the claim allowed.

Independent claim 7, rejected under 35 U.S.C. §103(a), as being un-patentable over Lip in view of Nguyen and Official Notice of which one aspect is newly-cited is allowable at least because the Newly-Cited Official Notice fails for reasons given above. It is respectfully requested that the 35 U.S.C. §103(a) rejection of claim 7 be withdrawn and the claim allowed.

Independent claim 13, rejected under 35 U.S.C. §103(a) as being un-patentable over Lip in view of Nguyen, Williams and Official Notice of which one aspect is newly-cited is allowable at least because the Newly-Cited Official Notice fails for reasons given above. It is respectfully requested that the 35 U.S.C. §103(a) rejection of claim 13 be withdrawn and the claim allowed.

Independent claim 18, rejected under 35 U.S.C. §103(a) as being un-patentable over Nguyen in view of Lip, Williams and Official Notice of which one aspect is newly cited is allowable at least because the Newly-Cited Official Notice fails for reasons given above. It is

respectfully requested that the 35 U.S.C. §103(a) rejection of claim 18 be withdrawn and the claim allowed.

Independent claim 20, rejected under 35 U.S.C. §103(a) as being un-patentable over Nguyen in view of Lip, Williams and Official Notice of which one aspect is newly cited is allowable at least because the Newly-Cited Official Notice fails for reasons given above. It is respectfully requested that the 35 U.S.C. §103(a) rejection of claim 20 be withdrawn and the claim allowed.

Furthermore, Applicants hereby incorporate herein by reference all arguments presented in their "Remarks" filed on August 27, 2009. In addition to the failure of the new grounds of rejection based on Newly-Cited Official Notice with respect to each independent claim, Applicants submit that these previous Remarks present arguments which also overcome the instant rejections which are based on references identical to those previously applied.

All dependent claims are allowable, at least for reasons based on their dependencies from allowable base claims.

AFFIDAVIT REQUESTED:

In any subsequent office action, if the Examiner maintains these rejections dependent upon the Newly-Cited Official Notice traversed herein, Applicants respectfully request that the Examiner provide an affidavit to support such Newly-Cited Official Notice taken in the next Office Action, as required by 37 CFR § 1.104(d)(2) and MPEP § 2144.03. The MPEP and the CFR are clear that the Examiner is required to support each instance of official notice when seasonably challenged.

Applicants call the Examiner's attention to the provisions of M.P.E.P. § 2144.03, regarding the "Procedure for Relying on Common Knowledge or Taking Official Notice" and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. M.P.E.P. § 2144.03 sets forth that "the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'" Further, any facts asserted as well-known should serve only to "fill in the gaps" in an insubstantial manner. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that such alleged evidentiary support is lacking in this instance because it has been refuted for reasons given above.

As M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, "[t]he standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA)" (citations omitted). M.P.E.P. § 2144.03 points out that "an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support" (citations omitted). In view of the above, the Office Action does not provide substantial evidence on the record to show that Applicants' claimed features were unquestionably well-known.

Therefore, in view of the arguments and explanations given above, Applicants expressly traverse the Examiner's taking of Newly-Cited Official Notice and request that the Examiner either cite a competent prior art reference in substantiation of the conclusions in the Office

Action, or else withdraw the rejection. To the extent the Examiner is also relying on personal knowledge, Applicants request that the Examiner provide "an affidavit or declaration setting forth specific factual statements and explanation to support the finding." *See* M.P.E.P. § 2144.03.

Notably, in this instance, where the Examiner's statement (Office Action, pg 2) "This implied fact is not mentioned in Applicant's specification, leading Examiner to [erroneously] conclude that the steps necessary for 'one of the plurality of visitors' to have the required registration information for the plurality of potential visitors is old and well-known." has been refuted, and where that statement is specifically relied upon in the Office Action to support Newly-Cited Official Notice: "Official Notice is given that it is old and well-known for one party to register another party (*as implied by Applicant's specification*)" (Office Action pgs: 5, 12, 16 and 20; emphasis added), this seasonable request for such affidavit is particularly appropriate.

CONCLUSION

Reconsideration and allowance are respectfully requested in view of the foregoing remarks.[2] All rejections have been addressed and have been overcome.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,
Verizon Corporate Services Group Inc.

By: _____
Joel Wall
Reg. No. 25,648

Date: **March 29, 2010**

Eddy Valverde, Patent Paralegal
Verizon Patent Management Group
1320 North Courthouse Road, 9th floor
Arlington, VA 22201 - 2909
Tel: 703.351.3032
Fax: 703.351.3665
Customer No. 25,537

[2] As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.